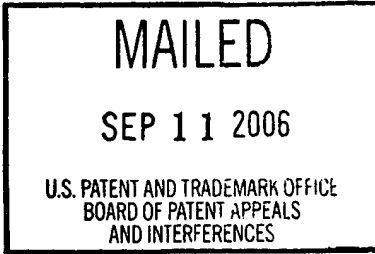


UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte STEPHEN JOSEPH VESPER

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Appeal No. 2006-3008  
Application No. 09/866,793

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ORDER REMANDING TO EXAMINER

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This application was received at the Board of Patent Appeals and Interferences (BPAI) on August 3, 2006. Subsequent to a preliminary review, a docketing notice was mailed on August 17, 2006. However, a second review of the application has revealed that the application is not ready for assignment to a panel of judges for a decision on the appeal. Accordingly, the application is herewith being remanded to the Examiner for her attention to the matter(s) below:

In a Memorandum to the Technology Center Directors and Patent Examining Corps dated April 29, 2002 and entitled "Reliance upon abstracts and foreign language documents in support of a rejection," the Deputy Commissioner for Patent Examination Policy mandated that

[e]ffective immediately, no appeal should be forwarded to the Board of Patent Appeals and Interferences for decision where . . . a rejection is supported in whole or part by a prior art document not in the English language, unless accompanied by a translation of the prior art document into English." <sup>1</sup>

One of the references applied to the rejection(s) of the appealed claims and listed in the Evidence Relied Upon section of the answer (pgs. 3-4) is "Ebina et al Japanese Journal of Medical [sic: Medical] Mycology 39(2): 155-160, 1997." This reference has some English language text (e.g., tables, figs. description) however, the body of the reference is in Japanese. A complete English language copy of the reference is required.

Additionally in the Evidence Relied Upon section of the answer, in the reference listed as "Ebina et al Japanese Journal of Medical Science and Biology 53(3):140, 1982" (emphasis added) the volume/no. should be 35(3), and in the reference listed as "Yakota et al. Microbiology and Immunology, 21(1):11-22, 1997." (emphasis added) the year should be 1977. Also, it appears as if the reference listed as "Watanabe et al., Journal of Tohoku Pharmaceutical University, 46:145-148, 1999 abstract", should, according to the corresponding reference in the IFW, be - Watanabe, Microbiology 145, 689-694 (1999) abstract. Clarification of these discrepancies is required. The examiner should review the answer

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<sup>1</sup> See related content in the Manual Of Patent Examining Procedure (MPEP) § 706.02. (II), (8th ed., Rev. 3, August 2005).

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in its entirety to insure that all of the reference information is listed correctly throughout the answer.

Accordingly, this application is remanded to the examiner to:

1. have a complete copy in the English Language of the Ebina et al. 1997 reference noted above, added to the file and scanned into the application IFW,
2. issue a revised examiner's answer, correcting the errors in the Evidence Relied Upon section as noted above and any other errors that may be found with respect to the cited references, and
3. for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By:

  
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DMS/vsh